



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,284	02/13/2001	Mikio Hashimoto	203058US2RD	9450

22850 7590 07/01/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SON, LINH L D

ART UNIT	PAPER NUMBER
----------	--------------

2135

DATE MAILED: 07/01/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,284

Applicant(s)

HASHIMOTO ET AL.

Examiner

Linh LD Son

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2,3, and 02/13/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashima et al, hereinafter "Takashima", (US/5701343).
3. As per claims 1, 6, 14, and 19, Takashima discloses the "Method and System for Digital Information Protection" invention, which include a program (digital information) distribution device for distributing executable programs (Col 1 lines 25-52) through a network to a client device having a tamper resistant processor (Computer card 3) which is provided with a unique secret key and a unique public key corresponding to the unique secret key (Decryption secret key) in advance (Col 6 line 60 to Col 7 line 32), the program distribution device comprising: a first communication path set up unit configured to set up a first communication path between the program distribution device and the client device (Col 6 lines 27-31); a second communication path set up unit configured to set up a second communication path directly connecting the program distribution device and the tamper resistant processor (Col 3 line 50 to Col 4 line

10, and Col 4 line 8 or Col 8 line 57 to Col 9 line 11), on the first communication path; an encryption processing unit configured to produce an encrypted program by encrypting an executable program to be distributed to the client device (Col 9 lines 34 to 63). However, Takashima does not teach the transmission unit configured to transmit the encrypted program to the tamper resistant processor through the second communication path. Nevertheless, Takashima does teach the implementation of the second communication path (cipher communication) for key transferring only (Col 3 line 50 to Col 4 line 10, and Col 4 line 8 or Col 8 line 57 to Col 9 line 11). Therefore, it is obvious at the time of the invention was made for one of ordinary skill in the art to implement the second path not only for the key transferring, but also to transfer the encrypted program to further secure the information.

4. As per claims 2 and 15, Takashima discloses the program distribution device of claim 1, further comprising: a user authentication unit configured to carry out authentication of a user who is using the client device, by using a user ID of the user received from the client device through the first communication path (Col 8 lines 39-45).
5. As per claims 3 and 16, Takashima discloses the program distribution device of claim 1, further comprising: a processor authentication unit configured to carry out authentication of the tamper resistant processor, by verifying a certificate

certifying that the tamper resistant processor surely has the unique secret key and the unique public key, which is received from the client device through the second communication path (Col 9 lines 37-63).

6. As per claims 4 and 17, Takashima discloses the program distribution device of claim 1, wherein the encryption processing unit encrypts the executable program by using the unique public key received from the tamper resistant processor through the second communication path (Col 3 line 50 to Col 4 line 10, and Col 4 line 8 or Col 8 line 57 to Col 9 line 11).
7. As per claims 5 and 18, Takashima discloses the program distribution device of claim 1, wherein the encryption processing unit encrypts the executable program by using a common key, and encrypts the common key by using the unique public key received from the tamper resistant processor through the second communication path (Col 3 line 50 to Col 4 line 10, and Col 4 line 8 or Col 8 line 57 to Col 9 line 11); and the transmission unit transmits the encrypted program along with an encrypted common key to the tamper resistant processor through the second communication path (See Claim 1 Rejection).
8. As per claims 7 and 12, claim 1 is incorporated. Further, Takashima also teach a client device for receiving programs distributed from a program distribution device through a network (Col 6 lines 25-40)

9. As per claim 8, Takashima discloses the client device of claim 7. However, Takashima does not teach a user authentication unit configured to carry out authentication of a user who is using the client device with respect to the program distribution device, by transmitting a user ID of the user to the program distribution device through the first communication path. Nevertheless, Takashima teaches the password and encryption keys saved in the card. The password is only used for user authentication to the card terminal and the encryption keys, such as public key, get transfer back and forth to the program distribution device. Further, the program distribution device, also called the information center 1, has "memory for storing public keys and certificates of the computer card for verification purpose (Col 6 lines 41-59). Therefore, it is obvious at the time of the invention was made for one of ordinary skill in the art that Takashima also have capability to authenticate the card terminal using the user ID concurrent with the public key and certificate to verify the computer card terminal's authorization and at the same can verify billing info if necessary.
10. As per claim 8, Takashima discloses the client device of claim 7, further comprising: a certification unit configured to carry out authentication of the tamper resistant processor with respect to the program distribution device, by transmitting a certificate certifying that the tamper resistant processor surely has

the unique secret key and the unique public key, through the second communication path (Col 9 lines 37-63, and Col 6 line 60 to Col 7 line 13).

11. As per claim 10, Takashima discloses the client device of claim 7, wherein the program receiving unit receives the encrypted program which is encrypted by using the unique public key notified from the tamper resistant processor to the program distribution device through the second communication path (Col 9 lines 37-63, and Col 6 line 60 to Col 7 line 13).
12. As per claim 11, Takashima discloses the client device of claim 7, wherein the program receiving unit receives the encrypted program which is encrypted by using a common key, and an encrypted common key which is encrypted by using the unique public key notified from the tamper resistant processor to the program distribution device through the second communication path (Col 9 lines 37-63, and Col 6 line 60 to Col 7 line 13).
13. As per claim 13, same basis of claim 1 rejection is applied. It is obvious that a communication between two parties requires interaction of both parties.

Conclusion

14. Any inquiry concerning this communication from the examiner should be directed to Linh Son whose telephone number is (703)-305-8914 or Fax to 703-746-9821.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Y. Vu can be reached at (703)-305-4393. The fax numbers for this group are (703)-872-9306 (official fax). Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-9600.

Linh LD Son

Patent Examiner

Handwritten signature
DU 2135